

IN THE MATTER OF AN OPPOSITION by CanWest Global Communications Corp. and Global Communications Ltd. to application No. 1,003,659 for the trade-mark GLOBO TV INTERNATIONAL & Design filed by TV GLOBO LTDA.

On January 29, 1999, TV GLOBO LTDA. (“the applicant”), filed an application to register the trade-mark GLOBO TV INTERNATIONAL & Design (“the application”) illustrated below:



The application is based on proposed use of the mark in Canada for the following services:

news agency, television broadcasting, television production, television programs, television shows; television entertainment in the nature of news, soap opera, series, sport, show and variety all distributed by television.

The application was amended to include a disclaimer of the words “TV” and “INTERNATIONAL” and was advertised for opposition purposes on November 14, 2001.


CanWest Global Communications Corp. and Global Communications Limited (collectively referred to as “the opponents”), filed a statement of opposition against the above mark on January 11, 2002, a copy of which was forwarded to the applicant on January 22, 2002. The applicant filed its counter statement on February 22, 2002.



The opponents filed as its evidence the affidavit of Scott McLeod.



The applicant filed as its evidence the affidavit of Catherine Lemay as well as a certified copies of application no. 1,003,660 together with the client proof sheet regarding that application, and certified copies of registered trade-marks THE GLOBAL VOICE, GLOBAL CAMPUS and GLOBAL CHILDREN’S COUNCIL.


The opponents filed a written argument and an oral hearing was held at which only the opponents were represented.

The first ground of opposition is that the applied for trade-mark is not registrable pursuant to s. 12(1)(d) of the *Trade-marks Act*, R.S.C. 1985, C. T-13 (“the Act”) because it is confusing with the following eight registered trade-marks owned by the opponents (collectively referred to as “the GLOBAL trade-marks):

Trade-mark	Registration No. and Date	Wares and Services
GLOBAL Design 	TMA494,576 May 14, 1998	<p>Wares: Pre-recorded video tapes, films, cassettes and disks.</p> <p>Services: Services relating to the creation, production, scheduling and broadcasting of messages and programs of every kind; telecommunication services namely, the transmission of messages and programs of every kind by radio waves, satellite, co-axial cable, fibre optic cable, or other means of telecommunications, whether encrypted or not; transmission of messages and programs of every kind by radio waves, satellite, co-axial cable, fibre optic cable, or other means of telecommunications, whether encrypted or not, to undertakings and/or the public for the reception thereof and the re-transmission of radio waves, satellite, co-axial cable, or fibre optic cable or other means of telecommunications.</p>

<p>GLOBAL NEWS & Design</p> <p>Global News</p> 	<p>TMA525,690</p> <p>March 23, 2000</p>	<p>Wares: Pre-recorded video cassettes, video discs, audio tapes and compact discs, and motion picture films.</p> <p>Services: Services relating to the creation, production, scheduling and broadcasting of messages and television programs; telecommunications services, namely, the transmission of messages and television programs by radio waves, satellite, co-axial cable or fibre optic cable, whether encrypted or not; transmission of messages and television programs by radio waves, satellite, co-axial cable or fibre optic cable, whether encrypted or not, to undertakings and/or the public for the reception thereof and the re-transmission of radio waves, satellite, co-axial cable or fibre optic cable.</p>
<p>GLOBAL Q & A</p>	<p>TMA520,607</p> <p>December 15, 1999</p>	<p>Wares: Pre-recorded video cassettes, video discs, audio tapes and compact discs and motion picture films.</p> <p>Services: Services relating to the creation, production, scheduling and broadcasting of messages and television programs; telecommunications services, namely, the transmission of messages and television programs by radio waves, satellite, co-axial cable or fibre optic cable, whether encrypted or not; transmission of messages and television programs by radio waves, satellite, co-axial cable or fibre optic cable, whether encrypted or not, to undertakings and/or the public for the reception thereof and the re-transmission of radio waves, satellite, co-axial cable or fibre optic cable.</p>
<p>GLOBAL TELEVISION NETWORK & Design</p> 	<p>TMA200,674</p> <p>July 19, 1974 (Expunged March 3, 2005)</p>	<p>Wares: Films, video tapes, discs and cassettes.</p> <p>Services: Operation of a television network, including the creation, production and telecast of programming of every nature and description for broadcast purposes.</p>

<p>GLOBAL TELEVISION NETWORK & Design</p> 	<p>TMA504,167 November 17, 1998</p>	<p>Wares: Pre-recorded video tapes, film, cassettes and disks.</p> <p>Services: Creation, production, scheduling and broadcasting of messages and programs of every kind; telecommunications services, namely, the transmission of messages and programs of every kind by radio waves, satellite, co-axial cable, fibre optic cable, or other means of telecommunications as defined under the Telecommunications Act (Canada), S.C. 1993, c.38 as amended, whether encrypted or not; transmission of messages and programs of every kind by radio waves, satellite, co-axial cable, fibre optic cable, or other means of telecommunications, whether encrypted or not, to undertakings and/or the public for the reception thereof and the re-transmission of radio waves, satellite, co-axial cable, or fibre optic cable or other means of telecommunications as defined under the Telecommunications Act (Canada), S.C. 1993, c.38 as amended.</p>
<p>GLOBAL TELEVISION NETWORK & Design</p> 	<p>TMA504,718 November 27, 1998</p>	<p>Wares: Pre-recorded video tapes, film, cassettes and disks.</p> <p>Services: Services relating to the creation, production, scheduling and broadcasting of messages and programs of every kind; telecommunications services, namely, the transmission of messages and programs of every kind by radio waves, satellite, co-axial cable, fibre optic cable, or other means of telecommunications as defined under the Telecommunications Act (Canada), S.C. 1993, c.38 as amended, whether encrypted or not; transmission of messages and programs of every kind by radio waves, satellite, co-axial cable, fibre optic cable, or other means of telecommunications, whether encrypted or not, to undertakings and/or the public for the reception thereof and the re-transmission of radio waves, satellite, co-axial cable, or fibre optic cable or other means of telecommunications as defined under the Telecommunications Act (Canada), S.C. 1993, c.38 as amended.</p>

<p>GLOBAL A CANWEST COMPANY & Design</p>  <p>A CanWest Company</p>	<p>TMA495,529</p> <p>May 29, 1998</p>	<p>Wares: Pre-recorded video tapes, film, cassettes and disks.</p> <p>Services: Services relating to the creation, production, scheduling and broadcasting of messages and programs of every kind; telecommunications services, namely, the transmission of messages and programs of every kind by radio waves, satellite, co-axial cable, fibre optic cable, or other means of telecommunications, whether encrypted or not; transmission of messages and programs of every kind by radio waves, satellite, co-axial cable, fibre optic cable, or other means of telecommunications, whether encrypted or not, to undertakings and/or the public for the reception thereof and the re-transmission of radio waves, satellite, co-axial cable, or fibre optic cable or other means of telecommunications.</p>
<p>GLOBALTV.COM</p>	<p>TMA540,987</p> <p>February 8, 2001</p>	<p>Services: Creation, production, scheduling and broadcasting of messages and programs of every kind by radio waves, satellite, co-axial cable, fibre optic cable, interactive computer communication or other means of telecommunications, whether encrypted or not; transmission of messages and programs of every kind by radio waves, satellite, co-axial cable, fibre optic cable, interactive computer communication, or other means of telecommunications, whether encrypted or not, to undertakings and/or the public for the reception thereof and the re-transmission of radio waves, satellite, co-axial cable, fibre optic cable, interactive computer communication or other means of telecommunications.</p>

The second ground of opposition is that the applicant is not the person entitled to registration pursuant to s. 16(3)(a) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the GLOBAL trade-marks, which have been previously used in Canada by the opponents.

The third ground of opposition is that the applicant is not the person entitled to registration pursuant to s. 16(3)(b) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the GLOBAL trade-marks, in respect of which applications for

registration have been previously filed in Canada by the opponents and had not been abandoned at the date of advertisement of the applicant's application.

The fourth ground of opposition is that the applicant is not the person entitled to registration pursuant to s. 16(3)(c) of the Act because, as of the applicant's filing date, the applied for trade-mark was confusing with the following trade-names that have been previously used in Canada by the opponents: Global Television, Global Television Network, CanWest Global Broadcasting Inc., CanWest Global Communications Corp. and Global Communications Limited (collectively referred to as "the GLOBAL trade-names") and had not been abandoned at the date of advertisement of the applicant's application.

The fifth ground is that the applicant's trade-mark is not distinctive and is not adapted so as to distinguish the applicant's services from the wares and services of the opponents, in that there is a likelihood of confusion arising between the applied for trade-mark and the GLOBAL trade-marks and the GLOBAL trade-names.

Opponents' Evidence-in-chief

In Mr. McLeod's affidavit, sworn September 24, 2002, he identifies himself as the Director, Media Planning and Television at Global Communications Limited, one of the opponent corporations. Mr. McLeod appends as the first exhibit to his affidavit, copies of the opponent's registration particulars for the GLOBAL trade-marks printed from the Canadian trade-marks database available on-line. Mr. McLeod also states that the opponents use the trade-names "Global Television" and "Global Television Network". Attached as Exhibit "B" to his affidavit is a copy of a New Brunswick business name registration certificate, dated July 5, 2000, for "GLOBAL TELEVISION NETWORK" registered by Global Television Network Inc., which Mr. McLeod states is a wholly-owned affiliate of the opponent CanWest Global Communications Corp.

Mr. McLeod provides information about the opponents' television stations operating in Canada and its news and entertainment services carried by over 300 cable companies and provided to urban communities and, through satellite to, rural and remote communities across Canada.

Mr. McLeod also sets out a number of statistics relating to the opponents' market share of viewers in various urban markets in Canada. Aside from these assertions by Mr. McLeod there is no other evidence that verifies these claims to viewership. Exhibit "C" to the McLeod affidavit contains representative samples of the opponents' letterhead, newspaper advertisements and radio scripts displaying and referencing various of the GLOBAL trade-marks.

Mr. McLeod also provides approximations for the value of advertising expenditures incurred by the opponents at being in excess of \$30 million (Cdn) annually for the years 1999-2002.

Applicant's Evidence-in-chief

In her affidavit, Catherine Lemay, a student employed by applicant's agent, attached as an exhibit to her affidavit, a page from *The Canadian Oxford Dictionary*, containing the word "global" and its definition and the page where the word "globo" would have been located with its definition but no such word was listed.

The applicant also provided as evidence, certified copies, from the Canadian trade-marks register, of three (3) trade-mark registrations containing the word "global" and having television related services or news services as part of their list of wares and services. The applicant also provided a certified copy of its Canadian trade-mark application no. 1,003,660 for the word "GLOBO" claiming proposed use in Canada in association with news agency services, television broadcasting, television production, television programs, television shows; television entertainment in the nature of news, soap opera, series, sport, show and variety, all distributed by television. It should be noted that as of the date of this decision, applicant's trade-mark for "GLOBO" has been registered as TMA586,834.

Grounds of Opposition

Paragraph 38(2)(b) - Confusion

As for the opponent's first ground of opposition, the material date for considering the circumstances respecting the issue of confusion with a registered trade-mark pursuant to s. 12(1)(d) of the Act is the date of my decision (*Conde Nast Publications Inc. v. Canadian Federation of Independent Grocers* (1991), 37 C.P.R. (3d) 538). The opponent has met its initial evidentiary burden with respect to this ground of opposition by filing copies of its trade-mark registrations for the GLOBAL trade-marks.

The test for confusion is one of first impression and imperfect recollection. In applying the test for confusion set forth in s. 6(2) of the Act, the Registrar must have regard to all the surrounding circumstances including the following specifically enumerated in s. 6(5) of the Act:

- a) the inherent distinctiveness of the trade-marks and the extent to which the trade-marks have become known;
- b) the length of time the trade-marks have been in use;
- c) the nature of the wares, services or business;
- d) the nature of the trade; and
- e) the degree of resemblance between the trade-marks in appearance or sound or in the ideas suggested by them.

The weight to be given to each factor may vary, depending on the circumstances (see *Clorox Co. v. Sears Canada Inc.* (1992), 41 C.P.R. (3d) 483 (F.C.T.D.); *Gainers, Inc. v. Marchildon* (1996), 66 C.P.R. (3d) 308 (F.C.T.D.)).

The Registrar must bear in mind that the onus or legal burden is on the applicant to show that on a balance of probabilities there would be no reasonable likelihood of confusion between the trade-marks at issue as of the relevant date.

Finally, I would note that the opponents' registered trade-mark GLOBAL TELEVISION NETWORK & Design (TMA200,674) was expunged from the register on March 3, 2005. There are seven (7) remaining GLOBAL trade-marks that form the basis of this opposition. Since the opponents' evidence is primarily directed to registration no. TMA494,576 for the trade-mark GLOBAL Design and there is little, if any, evidence of use of the other six registered marks, a consideration of the issue of confusion with the GLOBAL Design mark will effectively decide the first ground of opposition.

As for s.6(5)(a) of the Act, I do not find that either mark is inherently strong. The applicant's GLOBO TV INTERNATIONAL & Design mark (the "applicant's mark") is comprised of a stylised globe shown through what could be perceived as a lens. The words "GLOBO", "TV" and "INTERNATIONAL" appear below the globe design, GLOBO being a coined word and both TV and INTERNATIONAL being disclaimed by the applicant. I do not consider that the globe design element of the mark significantly enhances its distinctiveness as it suggests that the applicant's television broadcasting and programming services are global in scope or reach. Neither do I consider that the design feature of the words GLOBO and TV adds to the distinctiveness of the mark since the fanciful script and font employed are intrinsic with the words (see *Canadian Jewish Review Ltd. v. The Registrar of Trade-marks* (1961), 37 C.P.R. 89 (Ex. C.)). There being no evidence of use or advertising of the applicant's mark, I can conclude that it has not become known at all in Canada.

In so far as the GLOBAL Design mark is concerned, the word GLOBAL suggests that the opponents' services are global in scope or reach and I do not consider that the crescent moon design significantly enhances the distinctiveness of the mark. As evidenced by Mr. McLeod and uncontested by the applicant, the GLOBAL Design mark has become known throughout Canada. Thus, the overall consideration of the inherent distinctiveness of the trade-marks and the extent to which they have become known favours the applicant.

The length of time the marks have been in use favours the opponent. As for s. 6(5)(c) and s.

6(5)(d) of the Act, the nature of the parties' services is essentially the same, or at least closely related and presumably the channels of trade would, or could, overlap.

With respect to s. 6(5)(e) of the Act, the marks bear little resemblance to each other in appearance or sound. "Although the marks are not to be dissected when determining matters of confusion, it has been held that the first portion of a trade-mark is the most relevant for purposes of distinction." (see *K-Tel International Ltd. v. Interwood Marketing Ltd.* (1997), 77 C.P.R. (3d) 523 (F.C.T.D.)). The opponents' GLOBAL Design mark is comprised of the word GLOBAL positioned above a crescent moon design while the applicant's mark has a stylized globe design as the first portion of the mark and the words "GLOBO TV INTERNATIONAL" as the second portion. The idea suggested by both marks is somewhat similar in the suggestion that the services provided by each party may be global or international in scope or reach.

State of the register in this case reveals three registrations not owned by either party containing the word "GLOBAL" for use in association with the same type of services as the parties to this opposition. This limited number of relevant registered marks alone does not allow me to make any meaningful inferences about their use in the marketplace.

The issue is whether a consumer who has a general and not precise recollection of the opponent's mark, will, upon seeing the applicant's mark, be likely to think that the two products or services share a common source. I find that a consideration of all the surrounding circumstances leads me to the conclusion that, on a balance of probabilities, there is not a reasonable likelihood of confusion between the mark GLOBAL Design mark in association with television and news and entertainment broadcasting services and the applicant's mark GLOBO TV INTERNATIONAL & Design used in association with the same services. My conclusion is based primarily on the differences between the parties marks. The design features of the marks are completely different as are the word portions. As stated in *Beverley Bedding & Upholstery*

Co. v. Regal Bedding & Upholstery Ltd. (1980), 47 C.P.R. (2d) 145 (F.C.T.D.), affirmed 60 C.P.R. (2d) 70, “Realistically appraised it is the degree of resemblance between trade-marks in appearance, sound or ideas suggested by them that is the most critical factor, in most instances, and is the dominant factor and other factors play a subservient role in the over-all surrounding circumstances.”

In view of these conclusions above, I find that the applicant has satisfied the burden on it to show that there is no reasonable likelihood of confusion between the marks at issue. Therefore, the first ground of opposition is unsuccessful.

The second and third grounds of opposition are that the applicant is not the person entitled, pursuant to s. 16(3)(a) and (b) of the Act, to registration of the trade-mark due to confusion with the opponents’ GLOBAL trade-marks previously used or previously filed in Canada by the opponent for television and news and entertainment broadcasting services. The material date with respect to these grounds of opposition is the filing date of the application, January 29, 1999. The opponent has met its initial burden with respect to the entitlement ground of opposition by evidencing use and the filing of its GLOBAL Design trade-mark prior to the filing of the applicant’s application and non-abandonment as of the advertisement of the applicant’s application.

The second and third grounds therefore turn on the issue of confusion between the applicant’s mark and the GLOBAL Design mark as of the filing date of the application. The onus or legal burden is on the applicant to show no reasonable likelihood of confusion as of that date. My conclusions with respect to the first ground of opposition are also applicable here and I find that the applicant has satisfied the burden on it to show no reasonable likelihood of confusion between the opponents’ GLOBAL Design mark and the applicant’s mark for use in association

with television and news and entertainment broadcasting services. These two entitlement grounds of opposition are therefore unsuccessful.

The fourth ground of opposition is that the applicant is not the person entitled, pursuant to s. 16(3)(c) of the Act, to registration of the trade-mark due to confusion with the opponents' GLOBAL trade-names that have been previously used in Canada by the opponents, namely: Global Television, Global Television Network, CanWest Global Broadcasting Inc., CanWest Global Communications Corp. and Global Communications Limited that had not been abandoned at the date of advertisement of the applicant's application. The material date with respect to this ground of opposition is the filing date of the application, January 29, 1999. The opponent has not met its initial burden with respect to this ground as the only evidence of use of a GLOBAL trade-name was a New Brunswick business name registration certificate dated July 5, 2000 which is after the relevant date. This entitlement ground of opposition is therefore unsuccessful.

As for the fifth ground of opposition, the onus or legal burden is on the applicant to show that its mark is adapted to distinguish or actually distinguishes its services from the wares and services of others throughout Canada (see *Muffin House Incorporated v. The Muffin House Bakery Ltd.* (1985), 4 C.P.R. (3d) 272). The material time for considering the circumstances respecting this issue is as of the filing of the opposition, in this case January 22, 2002 (see *Re Andres Wines Ltd. And E. And J. Gallo Winery* (1975), 25 C.P.R. (2d) 126 and *Metro-Goldwyn-Meyer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.) at 324). Finally, there is an evidential burden on the opponent to prove the allegations of fact in support of its ground of non-distinctiveness.

Insofar as the fifth ground is based on an allegation of confusion with the trade-mark GLOBAL Design used for the wares and services identified in registration no. TMA494,576 it essentially turns on the issue of confusion between that mark and the applicant's GLOBO TV INTERNATIONAL & Design mark. My conclusions in respect of the first ground of opposition are relevant in this respect and I find that the marks at issue were not confusing as of the filing of the opposition. The fifth ground of opposition is also unsuccessful insofar as it is based on the use of the opponents' GLOBAL Design trade-mark as registered under no. TMA494,576.

Having been delegated by the Registrar of Trade-marks by virtue of subsection 63(3) of the Act, I reject the opponent's opposition to application no. 1,003,659.

DATED AT GATINEAU, QUEBEC, THIS 22nd DAY OF FEBRUARY, 2007.

Lisa A. Power
Acting Director,
Trade-marks Branch